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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,456	12/08/2003	Robert G. Metzger	5490-000317	2923

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EXAMINER

SWIGER III, JAMES L

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/730,456	Applicant(s) METZGER ET AL.	
	Examiner James L. Swiger	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10, 13-16, 18-24 and 28-33 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 11, 12, 17 and 25-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/10/04; 7/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

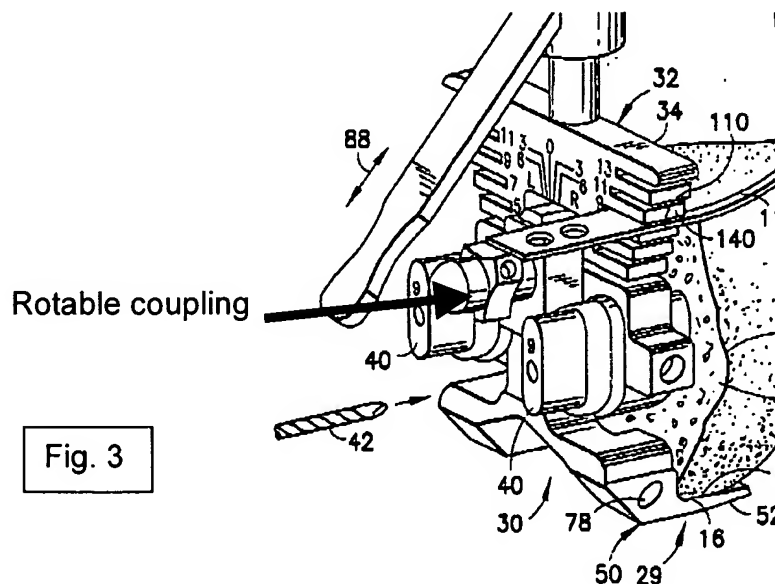
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-4, 8, 21-24, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Harwin et al. (US 6,458,135). Harwin et al. disclose a femoral guide having an extension portion (30) configured to be adjacent to a posterior condyle surface of the femur, a base portion (32), a superstructure (90), and a graduated stylus (80) that is configured to be adjacent to the anterior condyle surface of the femur. Harwin et al. further disclose a device with a pair of feet (52, the second foot hidden in Fig. 3), the extension is rotably coupled to the base (See Fig. 3 below).



Further, the device of Harwin et al. disclose a slot to restrain the movement of the stylus (96) that is also capable of being along the transepicondylar axis of the femur (Col. 2, line 38), that is capable of being rotably coupled and is substantially parallel.

Claims 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Axelson, Jr. et al. (US 5,860,980). Axelson, Jr. et al. disclose a surgical apparatus for knee surgery capable of use on a femur comprising a base portion (20) with a first coupling mechanism (36), a fixed first foot portion (38) coupled to the first, a second foot portion (22 and 24) coupled to a third coupling mechanism (26), and a superstructure (16) slidably coupled to the base (via item 33). The feet are capable of being positioned adjacent to the posterior condyle surface of the femur, and the second rotatable foot portion comprises a worm gear (18) that is capable of yielding rotation in with its slidable attachment with the superstructure. It is also a predetermined distance from the rotational axis (See fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5, 10, 13-16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwin et al. in view of Axelson, Jr. et al. Harwin et al. disclose the claimed invention except for a worm gear disposed between the base and extension portion that is capable of causing rotation of the feet with respect to the superstructure,

base, and extension. Axelson, Jr. et al. disclose an apparatus with a gear capable of functioning as a worm gear (18), that is also capable of rotation with respect to the superstructure, base and extension (Col. 5, lines 1-9, and line 66 through Col. 6, line 15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Harwin et al. having at least a worm gear that angles with respect to the extension, base and feet in view of Axelson, Jr. et al. to better fit the condylar portion of the femur.

Claims 9, 19 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwin et al. '135 in view of Hodge (US 5,486,178). Harwin et al. disclose the claimed invention except for an actuator capable of disposing the superstructure with respect to the base. Hodge discloses an actuator (60) that is considered to move the two pieces together considered the superstructure (80) and base (82), and see Col. 4, lines 22-32. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Harwin et al. having at least an actuator to allow translation between the superstructure and base in view of Hodge to better configure the device in preparation for sizing the femur.

Allowable Subject Matter

Claims 6-7, 11-12, 17, and 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLS

 1/17/06


PEDRO R. LOPEZ
PRIMARY EXAMINER